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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,933	09/30/2003	Kevin I. Bertness	C382.12-0141	2370

7590 11/30/2004
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EXAMINER

TSAI, CAROL S W

ART UNIT	PAPER NUMBER
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2857

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/675,933

Applicant(s)

BERTNESS ET AL.

Examiner

Carol S Tsai

Art Unit

2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-30 and 32-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-30 and 32-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/14/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Information Disclosure Statement

2. The information disclosure statement filed October 14, 2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because none of International Search Report or NPL documentations is received. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2857

4. Claims 28-30, 35-38, and 46-55 are rejected under 35 U.S.C. 103(a) as being obvious over U. S. Publication 2003/0001579 to Bertness (referred thereafter as Bertness'579) in view of U. S. Patent No. 5,018,075 to Ryan et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

With respect to claims 28-30 and 35-38, Bertness'579 discloses a method of testing a storage battery, comprising: regarding a physical characteristic of the battery observed by an operator and response received from the operator (see paragraphs 0058 and 0060); determining battery type based upon at least one query response and testing the battery based upon a

Art Unit: 2857

measurement of a parameter of the battery and at least one response received from the operator (see paragraph 0061).

Bertness'579 does not disclose querying an operator with a query regarding an observation.

Ryan et al. teach querying an operator with a query regarding an observation (see col. 1, lines 13-21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bertness'579's method to include querying an operator with a query regarding an observation, as taught by Ryan et al., in order to determine the cause of one or more problems associated with a given subject (see Ryan et al. col. 1, lines 16-18).

As to claims 46 and 47, Bertness'579 also discloses the battery type comprising sealed lead acid (see paragraph 0003).

As to claims 48-55, Bertness'579 does not disclose expressly the battery type comprising spiral/deep cycle/an electrolyte gelatin/an absorbed glass matt/starting, light, ignition battery/sealed flooded/antimony/hybrid.

It is, however, considered inherent that Bertness'579's battery type comprising spiral/deep cycle/an electrolyte gelatin/an absorbed glass matt/starting, light, ignition battery/sealed flooded/antimony/hybrid (see paragraph 0020), because such types are known to be one type of batteries to be tested in order that diagnostic tests on batteries can be carried out.

5. Claim 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertness'579 in view of Ryan et al. as applied to claim 28 above, and further in view of U. S. Patent No. 6,316,914 to Bertness (referred thereafter as Bertness'914).

Art Unit: 2857

As noted above, Bertness'579 in combination with Ryan et al. teach all the features of the claimed invention, but do not disclose a dynamic parameter.

Bertness'914 teaches a dynamic parameter (see col. 3, lines 47-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bertness'579 in combination with Ryan et al.'s method to include a dynamic parameter, as taught by Bertness'914, in order that a parameter which is a function of a signal with a time varying component of battery can be measured.

As to claims 33 and 34, Bertness'579 does not disclose coupling to the battery with Kelvin connection.

Bertness'914 teaches coupling to the battery with Kelvin connection (see Fig. 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bertness'579's method to include coupling to the battery with Kelvin connection, as taught by Bertness'914, in order to allow current I to be injected into battery through a first pair of terminals while the voltage V across the terminals is measured by a second pair of connections.

6. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bertness'579 in view of Ryan et al. as applied to claim 28 above, and further in view of U. S. Patent No. 4,360,780 to Skutch, Jr.

As noted above, Bertness'579 in combination with Ryan et al. teach all the features of the claimed invention, but do not disclose a shape of the battery.

Skutch, Jr. teaches a shape of the battery (see Figs. 1 and 2).

Art Unit: 2857

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bertness'579 in combination with Ryan et al.'s method to include a shape of the battery, as taught by Skutch, Jr., in order to indicate to the user how a 9 volt battery with a rectangular shape or a 1.5 volt battery with a cylindrical shape is to be placed in the tester.

7. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bertness'579 in view of Ryan et al. as applied to claim 28 above, and further in view of U. S. Patent No. 4,723,656 to Kiernan et al.

As noted above, Bertness'579 in combination with Ryan et al. teach all the features of the claimed invention, but do not disclose a color of the battery.

Kiernan et al. teach a color of the battery (see col. 3, lines 1-11).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bertness'579 in combination with Ryan et al.'s method to include a color of the battery, as taught by Kiernan et al., in order to determine the battery being operating normally or defectively based on the color indicated.

8. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bertness'579 in view of Ryan et al. as applied to claim 28 above, and further in view of U. S. Patent No. 5,432,025 to Cox.

As noted above, Bertness'579 in combination with Ryan et al. teach all the features of the claimed invention, but do not disclose caps on the battery.

Art Unit: 2857

Cox teaches caps of the battery (see Abstract, lines 1-5).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bertness'579 in combination with Ryan et al.'s method to include caps of the battery, as taught by Cox, in order that a battery connection can be restored to enable the flow of current to start the engine of an automatable.

9. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bertness'579 in view of Ryan et al. as applied to claim 28 above, and further in view of U. S. Patent No. 6,008,652 to Theofanopoulos et al.

As noted above, Bertness'579 in combination with Ryan et al. teach all the features of the claimed invention, but do not disclose a tub connected to the battery.

Theofanopoulos et al. teach a tub connected to the battery (see Abstract, lines 1-7).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bertness'579 in combination with Ryan et al.'s method to include a tub connected to the battery, as taught by Theofanopoulos et al., in order to determine the battery voltages of each battery after it is mounted and connected within the tub to determine if the batteries have the desirable voltage and will operate as they are intended and are connected properly.

10. Claims 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertness'579 in view of Ryan et al. as applied to claim 28 above, and further in view of U. S. Patent No. 4,874,679 to Miyagawa.

Art Unit: 2857

As noted above, with respect to claims 43 and 44, Bertness'579 in combination with Ryan et al. teach all the features of the claimed invention, but do not disclose a visible liquid level of the battery.

Miyagawa teach a visible liquid level of the battery (see Abstract, lines 1-8).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bertness'579 in combination with Ryan et al.'s method to include a visible liquid level of the battery, as taught by Miyagawa, in order to promote viewing of each height of the liquid in each element of the storage battery.

11. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bertness'579 in view of Ryan et al. as applied to claim 28 above, and further in view of U. S. Patent No. 5,707,015 to Guthrie.

As noted above, Bertness'579 in combination with Ryan et al. teach all the features of the claimed invention, but do not disclose the brand label on the battery.

Guthrie teaches the brand label on the battery (see col. 8, lines 35-36).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bertness'579 in combination with Ryan et al.'s method to include the brand label on the battery, as taught by Guthrie, because the brand indication can be selected as the representative specific areas for further reducing the time required for the inspection.

Response to Arguments

12. Applicant's arguments with respect to claims 28-30 and 32-55 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol S. W. Tsai whose telephone number is (571) 272-2224. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S.

Art Unit: 2857

Hoff can be reached on (571) 272-2216. The fax number for TC 2800 is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2800 receptionist whose telephone number is (571) 272-1585 or (571) 272-2800.

In order to reduce pendency and avoid potential delays, Group 2800 is encouraging FAXing of responses to Office actions directly into the Group at (703) 872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 2800 will be promptly forwarded to the examiner.



Carol S. W. Tsai
Patent Examiner
Art Unit 2857

11/19/04
